EXHIBIT C

B.E. Meyers & Ca. v. United States

U.S., Court of Federal: Claims .: rengs B.B. Meyers & Co. v. United States

No. 97-120C

Decided July 21, 2000 PATENTS.

Trademark Office. - Reissue. -[1] Practice and procedure in Pateni and .. Broader claims sought (\$ 110.1313)

Patent construction - Claims - Broad or narrow (§ 125.1303)

to protect any type of pulsing circuitry taught device, not with any lype of pulsing circuitry? and plaintiffs cannot tely on its reliate claims? original application, and since plainbills dele-tion of "putsing diode" and "substantial pulsproper recapture of surrendered subject manreissue claims deals only with lens tystem of though reissue claims are broader than origidered during bilghal prosecution, even nal claims, since "broadening reissue" is per-mitted if parentee demonstrates that it did not citim ali inventions actually disclosed in ing current" limitations did not effect imter, in that subject metter protected in new hibits patentee from using reissue process to regaln protection for subject matter surren-Patent for infrared illuminator is not invalid for violation of "recapture rule," which proin prior art. mark belönging 10 tta competitor. See, e.g., Allen Précis. W. Didyer, 414 P.2d 93, 95 [149] USPQ 795 ['Useh 1966). That is not what occurred in the instant case, and it is not our place to expand Useh, state law beyond the outiles set by the Useh, Supreme Count of 15 diversity, judiction] is ... to ascertain and (10th Cir. 1993) ("As a federal bount, we are 1996) ("Our duty fas a federal court stiting in by the state's highest court. " (quoting Wood Eli Lilly & Co., 38 F.34 510; 513 (10th Cir. generally reticent to expand state law without cleur goidance from fake state's] highest court state Ins., Co., 82, B3d 350, 352. (10th. Cir. apply the most recent statement of state law 1994))); Taylor v. Phelan, 9. F.3d.882; 887 he absence of Utah Supreme Court precedent, by the lower Utah courts. See Sellers & Ail-

(2) Practice and procedure in Patent and Trademark Office - Reissue - Same Juvention (§ 110.1305)

> FIRMED as to all claims except the court's in Act claim and its dismissal of P&O's

The judgithefit of the district court is AF

A ...

grant of summary Judgment on P&G's Lan-

factual inquiry confined to objective total relevant inquiry is whether someone skilled in 11 eritical element of plaintiff's basic invention. that is basis for relative claim; in prosent case, and this determination involves essentially ordinary skill in art, plaimiff could fairly trave sure in connection with its original application for patent on infrared illuminator, would have considered "pulsing diode" to be recessiny or ctalmed riewly submitted subject marter in original application; but for inadvertent error pertinent art, after reviewing plaintiff's disclowhether reistue claims are for same invention disclosed in original application; must examthrough "objective eyes" of shmeone having Federal district court in determining ine entitity of disclosure and decide whether, manifested by original patent. on regizand, when there will be, so, apparatually to de-velop a record on the nature and factual bases for the dismissed claims in Texas and to comfour those with the Dan toritous interference claim, as to which we REVERSE and REMAND for further pronature and factual basis for the claim to the instant cute. See Worklam Natural Gas Co. K Orogick, 901 Priddy x Edelman, 883 F.Id 436, 442 (6th Cts. 1989); Flood x Harrington, 532 F.Id 1248, 1250 (9th Ch

was entered by the district count in the present case has no effect on our builted to resolve this appeal. See

Case for the Southern Dispire of Texas after Judgment

ceedings in accordance with this opinion.

1976). The rest sedicate implications can be addressed

F.2d 678, 681-82 (10th CA. 1991);

Trademark, Office Prosecution [3] Practice and procedure in Patent and

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Declaration/affidayits (§ 110.0913) ... /. Practice, and procedure in Patent and Trademark Office - Reissue - Error without deceptive intent (§ 110.1303)

satisfy "error" requirement of Section 251; 報告 日 1名 1856日 1 distaiss each unrecessary limitation present in: claims was not disclosed or made obvious by. since such recitation is generally sufficient to: claims, applicant is only required to identify i tigns, since declinations were reviewed und approved by 11.5. Patent, und Trademark OF., fice, and deference should be efforded in. PTO's decision in this regard; since declare. differences between original, and reissue claims, and need not form discussion solely to declarations is sofficient to satisfy requireand filed original specification failed to recog. aithough declarations do not fully specify and original claims and omitted from resiste terms of necessary and unnecessary, limitations, and level of detail provided in plaintiffs. prior an a nime of original application, and tion of founder and president of plaintiff comment, plaintiffs, saltsfied requirements of 35. U.S.C. § 251, and the implementaling regule pany explained that attorney who prepared nize tiat subject matter covered in reissig Reissue declarations submitted by infringeneats of Section 251.

Particular patents — Electrical — Night? .. Majon devices

Re. 33,572, Meyers, invisible tight beam motion for summary judgment this patent is not invalid granted in part. projector and night vision system, plainliffs.

and John Eargo; all tof 19.5; Department of Justice tion: Washington, D.C.) for defendant 1 . : 312summary judgment on issue of patent validity. D. William Toone, Bellevenue, Washilfot fer end, and compatible and a service a sublingiale Chuh-l Chiang, Rank W. Hungar, assistanti attoring, general, 'Nio J. DiPictor, director,' infringement. On parties! cross-motions foc. Plaintiff's motion granted in part and, denied a in part; defendant's motion denied of the 1945 E. Meyers against the United States for plucht

deemed unnecessary. For the reasons set out below, plaintiff's cross-motion for summary. motion seeking to establish the validity of the now complete; .. and . further . argument is ment, asserting that most of plaintiff's claims disputed patents. Oral. arguments took place: on-March 31, 2000, after which the court ordered supplemental briefing. The briefing is judgment is granted in part and denied in purt. devices. Defendam moves for summary judgshould be dismissed because the patents Plaintiff. has responded .by filing a cross-Defendant's cross-motion is denied. No. Re. 33,572. Plaintiff!; seeks damages from ment of the patents on certain night-vision which were allegedly infringed, are invalid. indgment on the validity of plaintiffs patent the United States based on alleged infringe-

Instead, the Illuminary housed in IR Light encased in a housing and then mounted atop aviewer that allowed the user to see objects il-The later versitin, referred to by the parties its cused the infrained light. The entire system was nal patented version of plaintiff's device, the while in operation, in other to prevent the di-FACTUAL BACKGROUND. Lers insed as lens taps, injoduted alop a viewer. the second generation Illuminator, abandoned Emitting Diode ("LED") which projected an IR-LED was designed to pulse off and off the use of the flashlightIR filter combination. des'as "infrared illuminators." The earty verpowered flashlights; with thinkied ("IR") fil: infrared beam through a lens system that for Plaintiff is a manufacture of vailous night vision devices. Among these devices. Among these devices are items-referred to by the parsions of these devices were essentially high luminated by the infrared beam. In the origi 場合・なるとはは一番をした With the second second

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electromagnetic radiation into a beam with a odel from burning out (w. '' beneave trade and Plaintiff later sbught to have patent No. 572 ofigural patent was too narrow in that ill inof "Younds it believed its lens system canable of "Younds the energy from is source id! reissued in broader form, alleging that the cluded limitations related to the pulsing of the IR LED within the original patches broadest claim. In its reissue explication, plaintiff indi-Action by B.E. Meyers & Co. Inc. and Brad.

BAME Meyer is folker and predicted of Brid E. Meyers, inc. (1984), Mr. Meyers thindelf, as Well in 1984; Spean as person is taking existen they will be referred to collectively as "phradiff"

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Bruttering Law 1997/1990 of the terror of the bruttering of the terror o

volve, situations in: which a: company attempts to profit from the reputation of its competitor

by selling one of its own products as that of its competitor or misappropriating a trade-

off; and "misappropriation of goodwill" fur-

will." (Appellants' Br. at 41.) Both "palming fair competition primarily in the context of palming off and misappropriation of good-

Supreme Coult has considered the tort of un-

P&O admils in their brief, that "the Utah

[Fed. Cir.), cen. denled, 469 U.S. 821 (1984). American Holsi & Derrick Co. v. Sowa & Sons, 725 F.2d 1350, 1359 [220 USPO 763] lar-pulsing circulty was used to control the power supply to the IR LED. Plaintiffs reissue application was ultimately granted after dent protection; regardless of whether particubeing reviewed by the same Patent and Trade

that plaintiffs re—issue patent for the illumit. nator is invalid for several reasons. It first asrule of 35 U.S.C. § 102(b) (1994) by offering to sell the patented device more than one year before it actually applied for patent protection.

serts that plaintiff violated the "on-sale bar"

In its motion, defendant attempts to show

mark Office ("PTO") examiner who dealt

with plaintiff's original claim.

Second, it claims that plaintiff improperly cel matter that it surrendered in order to dis-

used the reissue process to "recapture" sub-

On-Sale bar

specific to enable a person skilled in the art to id at. The second prong can be satisfied in at date; which means that the invention worked for its intended purpose, or (ii) by proving that prior to the critical date, the intions of the invention that were sufficiently mercial offer for sale print to the critical date; least two ways: (i) by proving that the invenventor prepared drawings or other descripclaimed invention was the subject of a comor patenting when it was offered for sale. See from was reduced to practice prior to the criti-Plaff. 525 U.S. at 67. The parry challenging evidence (1) that the product embodying the 102(b), prohibits the patenting of an invenyear prior to the date of the application for the patent is referred to as the "critical date." See w. Welly Elec., Inc., 525 U.S. 55, 57 (1998). A two-prong test is used to determine whether so on-sale bar exists. See the patent must prove by clear and convincing and (2) that the claimed invention was ready lion that had been on sale in the United States for mose than one year price to the date of the application for the patent. The date that is one The on-sale bar, found in 35 U.S.C. practice the invention. See id. at.67-68... g summary Judgment, arguing: that defendant's. theories are without merit, and that, because defendant has not pointed to further flaws in its patent, the court should declare the patent Plaintiff's statement of genuine issues idenciently, detailed. - Plaintiff, cross-moves. for patent application. Finally, It asserts that plaintiffs reissue claims are invalid because tinguish its device from other pre-existing inventions duiting the original patent applicaion process. Third, it argues that plaintiff's reissue claims are invalid because they do not cover the same device described in plaintiffs disclosure in connection with its original plainites reissue declarations are not suffi-

cal date of January 30, 1984. Defendam also alleges that plaintiff had reduced its patented by plaintiff after the critical date do not mean date, and that subsequent improvements made that the illuminator did not work for its in-Defendant alleges that plaintiff offered its patented illuminator for sale prior to the critiilluminator to practice prior to the critical lended purpose at an earlier time.

f defendant's proposed facts. There are, how-..

rectly points out, many of plaintiff's "genuine.

with which it disagrees, As defendant cor-

ssues" simply quibble with the phraseology ever, sufficient disputes of material fact in connection with defendant's first and third theory to render summary judgment inappropriste for either party. As for defendant's, ro-

liftes a number of defendant's proposed facts

Defendant presents several different examples standable confusion about the precise product being offered at particular times. This is beinfrared spot illuminators advanced and of what it contends were commercial offers for sale, and plaintiff socks to rebut each one. its primary argument; however; is that defendant's examples are misdirected due to undercause, even as the underlying technology for Plaintiff contends that it did not make a prior to Rebruary 1984, and that even if it had, the device was not ready to patent until 1984. commercial offer for sale of the illuminator

Palents are presumed valid, See 35 U.S.C.

DISCUSSION

maining two theories of invalidity, the court

concludes that summary judgment in favor of

plainiist is appropriate. ...

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the burden of proof in challenging plaintiff's

vincing evidence, See Azko v. E.I. Qu Pont de Nemours, 810 R.2d 1148, 1150-51 [1 USPQ2d [704] (Fed. Cir. 1987). Defendant also bears

of establishing invalidity by clear and con-

282 (1994). Defendant thus bears the burden

luminators in plaintiff's 1983 correspondence with customers do not necessarily indicate that the product being referred to is the spe-cific IR illuminator for which BEM eventually evolved, the terms used to describe the devices, namely infrared spot illuminators or IR Huminators, remained the same. For this reason, according to plaintiff, references to IR IIsought and received patent protection.

Mr Killion. The relevant portion of this letter indicates that BEM is offering Mr. Killion a. new product not yet described in BEM maron an August 31, 1983 letter from BEM to a offer for sale relied on by defendant is based The first example of an alleged commercial 1.7 reting brochures:

added illumination in minimal light situs., and comes with a near-infrared spotlight attached to the side. The spotligin provides tions. The total package sells for \$2,995.00, ing so I will describe it to you. It is a 2nd generation night vision device similar to the Noctron V It is a more compact package There is one product we have just completed that you will not find a flyer on. made to accept camera lenses of your choice, has a 2" viewscreen on the back, However, I think you would find it appeal-

with an IR LED. The latter is the device that? "near-infrared spotlight" mentioned in this it was the latter, however, then the letter was... 1 filter, or the second igeneration illuminator an offer to sell the patented device, and the only issue remaining would be whether the device itself was ready to patent at some time The parties vigorously dispute whether the letter is a first generation flashlight with an IR was ultimately patented by BEM. If it referred to the former, then the letter to Mr. Killion was not an offer to sell the patented device. If prior to the critical date.

than the flashlight and IR filter, because the light: It points to exhibits of earlier BEM: that the near-infrared spoulight reference in Killion letter is discussing a new product not Defendant points our that the reference to a product brothures, which offered to sell a flashight and an IR filter, and which referred mington." These exhibits show that the flashlight and IR filler were priced and sold separately. This shows, according to defendant, the Killion letter had to be something other new product in the Killion letter encompasses to these items as an "infrared and white illuboth the viewer and the near-infrared spot-

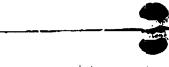
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ented illuminator.2 Defendant argues that Lug-inbill's testimony shows that plaintiff was oftering to sett Kuiton the same illuminator for which plaintiff ultimately received patent proneai—Infrared spoilight referred to in the Kil-lich letter was "the prototype infrared illumi-riator," and not the Streamlight Rashilght with an IR files. Defendant argues that the protomodel" of the IR illuminator, which used an IR LED to project a beam of infrared light that rould be seen through a viewer. The smoking model was plainliff's earliest version of the device that eventually became the paitype illuminator referred to by Mr. Lugiobill was what both parties call the "smoking ight and IR filter had been offered and sold in Defendant also relies on deposition testimony from a Mr. George Luginbill, a former BEM sales representative who worked with whose signature appears at the bottom of the Killion letter, testified that he believed the BEM unul September 1983. Mr. Luginbill BEM brochures since at least 1982. tection.

From-cooper&dunham

1983, which indicate that Mr. Killion had pur-chased a Dark Invader second gene ion night was merely a flashlight with an IR filter. There the near-infrared spotlight referenced in the August 31 Killon letter must have been a new type of illuminator similar to the one refer-19 letter to Mr. Kruglak, in which Mr. Meyers ration of the device in the photo refuter any possibility that the tofrared spot illuminator re, according to defendant, because the infraing the Kruglak letter is not a flashilght, and because the Killion work orders indicate that viewer along with an "infrared spot illuminator." Defendant then points to the September ond generation Dark Invader image intensifier red spot illuminator in the photo accompany. he had ordered an infrared spot illuminator Defendant attempts to draw a connection between the device offered in the Killion letsent to a Mr. Ross Kruglak, another BEM custoner. Defendant references BEM work of-ders from September 6 and September 15, in indicates he is enclosing pictures of a secalong with an attached infrared spot illumina-tor. Defendant argues that e physical configuier and the device offered and photographed in connection with a September 19, 1983 letter

1ED would burn out after apportinguely one bour of continuous are It was called the motiving model because the





S6 USPQ24

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reissue claims, because of the deference given

to decisions of the patent examiner. See 14.;

separate invention that qualified: for indepen-

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B.E. Meyers & Co. w United States

smoking model. Meyers testified during his that this supports the conclusion that the illuminator prepared for Mr. Killian in November light and IR filter an emitter. Defendant argues of 1983 was the same as the patented IR LED it, BEM informs Killion that he is receiving a Dark liveder night viewer, but not a infrared spot illuminator. The invoice explains that the lers" were similar to the IR LEDs used in the deposition that BEM did not refer to the flash; enced in the Kruglak letter, and not, as plain-uff would have it, a flashlight with an IR filter BEM's November 1983 involve to Killion. In infrared spot illuminator is back-ordered because BEM had not received its "infrared emitters." Defendant, citing to Mr. Meyers' deposition testimony, argues that these "emit-Defendant's final argument relates

light" was being touted as a new product.
In response to defendant's second, argu-In response to defendant's first point, plain-اللا ويهليج الموا المد الجهر بالتطليب وعجبالهما إلا the Killion letter was the second generation Dark Invader viewer, and that there is recthing dant's conjection that the "near-infrared spotin the language of the letter to support defen-

illuminator, and not a flashlight with an IR fil-

ment, plainiff offers testimony from another BEM employee, Mr. Patrick. He was shown the Killion, letter, and testified that he believed, given the date of the letter, that it reposed to the IR LED illuminator. Plaintiff also ferred to the flashlight with IR filters as op-

that the filter appears as a separate term in the photo-gruph. Defendant contends that because the better and the photograph made a distinction between an infrared spot illominator and an IR facility and filer, it would unrestocable to later that they were one and the Defendant also argues that the Kruglak learn refers rately and used with a Streamlight Bashilght. It assens to an IR filter as an Item that could be purchased sepa-

duce a man-stood ages at a distance of approximately 400 feet. Defendant argues that the characteristics of the illuminator deskribed in the Geracinosis letter are impony, buwevez, is equivocal as to what he was admittion that the Illuminator referenced in the Germinnoff letter may have been the smoking model. Mayers' tes-* In connection with this argument defendace also points to a lotter frets Meyers to a Mr. Paul Geratinoff of the U.S. Army. The letter, dated November 18, 1983, the same us those described in plaintiffs new product bulled a for the putented illuminator. Defendant also points on that Mr. Meyers admitted during his deposti discusses an inforced spot illuminator that could pro-

gust. Along the same lines, plaintisf contends that Mr. Killion's own correspondence showed that he amicipated delivery of his date of his order, and so it makes no sense to estume that Mr. Killion was trying to buy a ary, it is illogical to assume that it was the product being offered to Mr. Killion to Aunight-vision device within two weeks of the product that plaintiff would not perfect until was not perfected until the following Februtestimony states that the IR LED illuminator county 1984.

above, and also points out that Mr. Meyers estified that the words "infraied spot illuminator" were sometimes used to describe the plainitf simply relies on the arguments noted In response to defendant's third argument, Stacklight-style ithuninger with an JR filter.

ever, defendant points out that this would con-November invoice. In its Initial opposition being presented in a footners that it was only because the Varo Rashlight was solictuited. Plaintiff implies that the "infrared emitter" in the Killion involve is a reference eminers" referred to IR LEDs of the type used in the patented illuminator, and not the flashlight with IR filter to Mr. Killion as to the Varo flashlight. In its response, howdeal's fourth argument regarding the Killion indict Mr. Meyer's testimony: that "Infrared staintiff offers finde in response to defensack-ordered that BEM did not deliver the Rachlight/IR filter combination:

nator developed for the FB1 and offered to other potential customers at the same time. Plaintiff argues that these letters demonstrate type illuminator originally designed for the Federal Bureau of Investigation ("FBI"), but subsequently abandoned. At oral argument, plaintiff's counsel highlighted a series of let-BEM personnel referred to a prototype illumi-As to defendant's arguments regarding plaintiff contends that these letters and demers from BEM dating to early 1983 in which other sales offers by BEM during late 1983. onstrations actually involved a different proto-

tion). Plaintiff argues that the entire pulsing

dicated that the illuminator was not being delivered due. to the inability to obsulo 19, emitten, as opposed to a The parties disputes over whether this FBH-illumi-nated was a hulb-based illuminator, or instead used some form of IR emitte, to project a beam through its Killen sile, because the November Kilism invoice inmore in connection with evuluation the effect of the cas system. This distinction may be of some impotack of balogen bulbs.

matter, affirmatively surrendered during the initial :patent prosecution, particularly where the purpose of surrender-was to distinguish the claimed invention from the prior art. See ing for a reissue claim. The law does not however, permit attempts to recapture subject . A party may broaden its patent while apply-Mentor Corp.: 998 F.2d at 995-96. all of the developmental work on the patented: urgument, plaintiss also sought-to clarify its and that much of the 1983 sales activity. polniced to by defendant involved this FBI privi otype, later abandoned, as opposed to the position on this issue by arguing that nearly xolotype of the patented illuminator. At oral an unbroken chain of development for a prootype illuminator that lasted into late 1983,

Mentor Corp. v. Coloplast, Inc., 998 F2d 992, 11500 2100 (Ked Cis 1014) If a missing of 211 lier; the recapture rule does not apply. See See id. Determining whether a reissue claim is broader than a canceled claim involves more ements or claim limitations. See Ball Corp. v. United States; 729. F.2d 1429, .1436 [221 broadens a patent in a way that does not attempt to recepture what was surrendered earmine whether the broader aspects of the reissue claim relate to subject matter surrendered during the prosecution of the original patent. than simply counting the number of claim el-The first step in applying the tecapture rule Srein, 142 F.3d 1472: 1480 [46 UPQ2d 1641] (Fed. Cir. 1998). The second step is to deteris determining "whether and in what respect the reissue claims are broader than the original palents." See Hester Industries, Inc. 996 [27 USPQ2d 1521] (Fed. Cir. 1993). Defendant's second theory is that plaintiff's ibility of winesses and to thaw informed from sometimes conflicting pieces of documentary evidence. The court therefore cannot and it is cornested. Proper evaluation of the appropriately enter summary judgment in favor of either party in connection with defenpatent is invalid because it allegedly recaptively compressed time period in late 1983 stantial evidence that the patented product was the issue as to what was for sale is one of fact, Although defendant has put forward subthese is some contrary evidence. In the end illuminator actually took place during a relaon sale more than one year prior to palenting

evidence requires the court to assess the

and early 1984.

broader aspects of the reissue claim attempt to recapture subject matter surrendered during patent. The dispute concerns whether the [1] In the present case, the parties agree that the first step towards applying the recapture rule has been satisfied, in that the reissue claims are broader than the original claims for which plaintiff received paters protection. Indeed, plaintiff concedes that the entire purpose in secking the teissue patent was to broaden the protection is had obtained in the original the prosecution of the original patent. fendant alleges that plaintiff surrendered sub-1521] (Fed. Cir. 1993) (discussing "recapture issue process to regain protection for subject matter surrendered during original prosecutimes subject matter surrendered by plaintiff ect matter regarding its polying diode during is initial application, and then deleted the plast. Inc., 998 F.2d 992, 995-96 [27 USPQ2d rule," which problibits patentee from using re-

same limitations while seeking approval for

during prosecution of its original patent. De-

Surrender and Recapture

dant's first theory of invalidity.

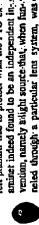
Is reissue claims. See Mentor Corp. v. Colo-

cuit would pulse on and off at intervals that resulted in it being off more often than on; and (2) that the pulsing circuit, when on, would pulse at a substantially higher level of power ing circuitry was already taught by the prior art; specifically Kaplan 4,290,043 and Laughlin 4,129,780. Plaintiff distinguished the prior thousandy. These limitations are referred to by the parties as the pulsing diode and substantial pulsing current limitations, respectively. In this case, plaintiff surrendered the right to have patent projection for a generic pulsing circuit in its original claim, because such pulsart by adding two limitations: (1) that the cirthan it would be able to sustain if left on contions, from its broadening reissue claim. Thismal and unnecessary pulsing diode limitation. capable of projecting a beam having a well defined peripheral edge. diode limitation was unnecessary to begin with, and that the only surrendered subject matter relates to limitations added to the carieties and unnecessary pulsing diode limitation.

which by definition includes the added limita-

move the entire pulsing diode

left plaintiff free to protect what the PTO ex-







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posed pulsing circuitry, was noo close to their orms of pulsing circuitry had already been to its independent claims because the patent ing these limitations, plaintiff surrendered the circuity that did not include these features. In essence, plaintiff conceded that more generic prior art to receive patent protection. In add-Plaigtiff's initial patent application: included a pulsing circuit element in each of its independent claims. Plaintiff added these limitations examines believed that plaintiff's original proright to receive patent protection for pulsing patented by other inventors.

delpue any reference to pulsing circuitry in the resistance chains. Of course, in doing so, plain-iff dejetfd the specific pulsing diode and suband the reissue statute is to be construed liber. course of prosecuting its reissue claims, plainfor this aspect of its invention, plaintiff had to grounds that BEM's altorney had not-claimed: [229 USPQ 673] (Ped. Cir. 1986). During the matchy agreed, that a lens apparatus that propulsing current limitations that had ocen suffied to its original claim to distinguish BEM, acting within the appropriate time pesoriginal application. Such a "broadening relsally. See In re Whetter, 790 182d 1576, 1579. ticular device. In order to receive protection Subsequent to receiving its original patent, Triod as defined by statute, petitioned for reissuance of the patent in broader form, on the all of the inventions actually disclosed in the sue" is permitted pursuant to 35.U.S.C. § 251; iff contended and the PTO examiner ultiduced a beam with a well-defined peripheral edge was in fact a separate invention cligible for patent protection, independent of whatever type of pulsing circuitry might be used in combination with the lens system in any parthe prior art. stantial

any type of pulsing circuitry. During the origipatent prosecution, the examiner made tion for its basic pulsing circuit design ber ect an improper recepture of surrendered subwith the lens system; it had nothing to do with ect matter. The subject matter protected in the plaintiff aware that it could not receive protectaught by the prior art. In this regard, nothing changed after the reissue process. Plaintiff still commit rely on its reissue claims to protect any téntial pulsing coreat limitations did not efnew independent reissue claims dealt only cause such pulsing circulary. was already Contrary to defendant's argument, plaindeletion of the pulsing diode and rub-뎔

the prior art, and therefore plaintiff has mot used the reassue process to (properly recaptureprosecution, Accordingly, defendant's motion for surimary judgition on the recapture issue is denied, and plaintiffs cross-motion for. subject matter sumendered during the original type of pulsing circuit design that is taught by summary judgment on the same issue granted.:

"Original patent" requirement

a lens system arranged in such a way that the light from the source of radiation is incursed into e beam having a well-defined pelipheral coge. These four elements can be extracted

electromagnetic radiation in said housing, and

four basic elements: a housing, a source of

(2) The description of plantiff's device in the independent reissue claims incorporates

tice by someone skilled in the lart following a review of the original patent specification.

bination of elements could be reduced to prac-

claims, because an invention having this porn-

the independent reissue

contends that nothing in the original patent extend patent protection to an invention that is different from the one described in BEM's disclosed to anyone skilled in the art how to build an illuminator without using a pulsing circuit, and thus the reissue claims improperly Desendant also alleges, thus plaintiff's parents are invalid for falling to comply with the "original patent" clause of 35 U.S.C. § 251. Section 251 requires that a reissue patent be granted "for the invention disclosed in the original patent," Defendant argues that plaintiffs original patented device required a pulsing circuit in order to function, and that the absence of such pulsing circuity maker relasule claims 35 through 46 invalid. Defendant original patent application.

trol circuit that pulsed an IR LED on and off

In a particular manner. In determining whether the new claims are for the invention originally

radiation," the independent claims, described

original specification was far more specific with respect to the source of the beam. Rather than referencing "a source of clockromagnetic in the original specification referenced a con-

from the original patent specification, but the

equalely described in the original patent application specifications. Claim 35 of the reissue in the broadest reissue claim, claim 35, is ad-Plaintiff responds that the device projected

(Fed. Cir.: 1991)

source: of said electromagnetic radiation-in said housing; and a lens system in said house. ing and aligned with said source for forming. quality of an image of a target produced by, a hancer, said device comprisings, a housing; a the energy emitted from said source, into a Aldevice for illuminating a target with a beam of electromagnetic radiation to enhance the passive visible light intensifier and image enbeam with a well defined peripheral edge. palent covers:

nation of an infrared emitter aligned with a: issue patent improperty allows this limitation: to substitute for the more specific limitations: regarding a pulsing light source described in conginal parent claims. Plainiff responds by arguing that essential element of BEM's inlens system in an illuminator bousing." Plain-Defendant focuses its argument largety on the vention protected by claim:35 is "the combireference to "a rounce of said electromagnetic radiation in said housing." arguing that the reiff insists that the patent examiner acted prop-

evaluated the pecessity of pulsing at the time judgments; therefore, cannot properly, be manifesied by the original patent." See In re Rowand, 726-F.2d 558, 560 [187 USPQ 487] (CCPN 1975). The court, however, has not pakies submitted expert affidavits discussing how romeone skilled in the art would have of plaintiffs original disclosure. Summary heard testimony bin this issue, not have the This determination involves "an essentially factoral inquity confined to the objective intent granted in favor of either party on this issue. necessary or critical element of plaintiffs ba-393-94 [221 USPQ 952] (Fed. Cir.: 1983) sic invention. See "In re Perers, 723 F.2d 891 have considered the pulsing of the diode

Reissue declarations

Packard Co. v. Bousch & Lomb. Inc., 1812 F.2d 1556, 1565. [11 USPQ24 1750] (Fed. Cu. 1989), cer. denied, 493 U.S. 1076 (1990). Plaintiff acknowledges that its reissue decigra-tions must complis such information, tut comarguer ihat gininiiff. declaratione must show application arose, as well as how and when Defendant's final theory is that plaintiffs reissue claims are invalid because the reissue declarations filed by Mr. Meyers in support of those claims lack sufficient detail. Defendant when and why the error in its original patent the alleged error, was discovered. See Hewleri. application, but for the inadventent error that is the basis for the reissue claim. See In re-Amox, 953 P.2d 613, 618 [2], USPQ2d, 1271] 行為 不知 有情情情 行一時 As applied to the pending motion, the rel-

and decide whether, through the "objective,

eyes" of someone having ordinary skill to the newly submitted subject matter in the original

art, plaintiff could fairly have claimed the

disclosed in the first application, the court,

must examine the entirety of the disclosure

Packard Co. v. Bousch & Lomb, Inc., Na. 1920.
1856. 1565. [11] USPQ2d 1759] (Fed. Cu. 1889). cer. denied. 493 U.S., 1976 (1990). Plaintiff acknowledges that its reissue deciagations must compan such information, but concerned thair if has satisfied the requirements of 35 U.S.C. § 221 and its imperimental of 18. C. F. g. 175 (1989).

[3] The court concludes that plaintiff's decire is under the court concludes that plaintiff's decire is under the declarations where reviewed and approved by the PTO, and that deference approved by the PTO, and that deference spould be alforded to the PTO's decision in this regard. See Azio. 810 F.Zd at 1150-31. With Meyers, BEM's founder and president, filed the original specification falled to recognize that the automey who prepared and dependent retainer claims was not disclosed or deference in the declaration. Such as an initial declaration falled to recognize that the subject matter covered in the in-dependent retainer claims was not disclosed or deference in the international the control of the original specification. Such as an initial declaration is which he tare of the original specification falled to recognize that the subject matter covered in the in-dependent retainer. Such as an initial declaration is with a tractation is such the surface of the original specification. Such a recitation is iele. The. 1142 P.30 let 1479-80 ("One of the geherally sufficient to satisfy the "error" lag this combination of elements? (L.k.) this that their deads not include pulling) "out be made from a review of the connection with its original application, would was irrelevant, because the laveration was and ready for paternia, justil BEM had solved the birthous problem be ready for the readvant wood to privide the diddle from barming out was the patient control (see surficed to the independent cluding of pilbhuist). of pilbhuist. para. The public course treats, bowerers, was re-noved from the independent retays, admin. Plaintiff justice this conveil is constant with the "criptial patent" requirement by environ that "an inveditor have evant inquiry is whether someone skilled in: he art, after reviewing plaintiff's disclosure in a Abbongh not dispositive at this stage, the court ontes thát there is significad decaton between plathis (T'E) aryuments on the "original patien" theory, and the "on-sale has" theory. Plaintiff attents to avoid the op-sale but in part, by sepaing that any when additing in 1983

inspirate paintiffs argument than in illuminator was more ready for patenting until after BEM had encertifully liver transpirately for patenting until after BEM had encertifully liver comparated the pulsing control circuit lade the confining original patent's specification. This appears to rept.

a broadening reassue is the failure of the patentec's attorney to appreciate the full scope of the invention during the prosecution of the

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original patent application. This form of error.

Fischer v. Viacom International Inc:-

has generally been accepted as sufficient to salisfy the 'error' requirement of § 251.") (internal citations ornitted).

ration" could simply have explained that the ney oversight" explanation accepted in Amos "failed to recognize" the proper scope of the Defendant seeks further explanation of how the error arose, but, citing In re Amos, 952 alleged error was due to an oversight by the prosecuting attorney. The court, however, sees no meaningful distinction between the "attorand plaintiffs alleguion that its attorney F.2d at 615, admits that "an acceptable deciainvention.

tween the original claims and the reissue line by line identification of the differences between the original claims and the reissue Defendant relying on In re Constant, 827 also complains that plaintiff's declarations do limitation present in the original claims and claims, and it does not require the patence to frame the discussion solely in cerus of necessupplemental reissue declaration underrook a uff's cross-motion for summary judgment is F2d 729, [3 USPQ2d 1762] (Fed. Ctr. 1987), not fully specify and discuss each unnecessary omitted from the reissue claims. As administra points out, however, Constant simply requires the patence-to identify the differences be-Sary and undecessary limitations. Plaintiffs claims, and the level of detail provided in the Supplemental declaration is sufficient to satisty the requirencenes of section 251. Accordingly, defendant's cross-motion for summary judgment on this theory is denied, and plainranted

CONCLUSION

ciercy of plaintif's reissue declarations. On or before August 18, 2000, the parties are different rected to provide the pourt with a joint status. theory and original patent theory of invalidity mary judgment is granted with respect to the The parties' cross-inctions for summary judgment in connection with the on-sale bar are denied. Plaibliff's cross-motion for sumrecipulate theory of invalidity and the suffireport outlining a proposed schedule for fig-ther proceedings,

District of Maryland U.S. District Court

Fischer v. Viacom International Inc.

Decided August 16, 2000 No. IFM-00-357

COPYRIGHTS

Statutory preemption 11 Elements of copyright - Federal pre-15 205 (1803) TRADEMARKS AND UNFAIR TRADE PRACTICES

;- Preemption .. . Unfair competition (§ 395.02)

breach of confidential arrangement, which is children's television program, are equivalent. to exclusive rights granted by Copyright Act,

Krghts asserted in plainliff's claim-for based on alleged misappropriation of idea for

> program, detailed written description, scripi for giloi episode, character description, and program is within stope of subject matter of copyright, since plaintiff's written proposal Idf "animatic" video lape are langible works that fall Within scope of copyright, since scope of particularly when those ideas are embodied in "Work" that is subject of plaintiff's state law claims, which are based by alleged misappropriation of idea for children's television subject matter of copyright may extend to the clude uncopyrightable material, such as ideas, and since plaintiffs idea therefore falls within or intermingled with copyrightable material. subjekt matter of copyright protection, even if idea liseif would not be presented by Copyight Act

plaimisf describe parties acting at arm's

and claim therefore is preempied by 17 U.S.C. § 301(a), since plaintiff does not allege that parties formed explicit agreement of trust or confidentiality, and since facts alleged by

COMMUNICATIS

2] Elements of cupyright -: Pederal prempilan - Statutory preemption \$ 205,0803)

confidence. On desendants' motion to dismiss. Harold M. Walter and Boyd K. Rutherford.

A said of Fig.

confidentiality.

Granted in part and denied in part.

TRADÉMARKS AND UNIÁIR TRADE PRACTICES

Unfaire, competition, experimental (§ 395.02), while we read in the Rights asserted in plaintiffs, claim

U.S.C. § 301(a), Since gravament of relain is that defendants took plaintiff's ideas and used them without proper compensation or attribution, and implied contract alleged by plamiff breach of implied-in-fact contract are equivalent: to exclusive rights granted by Copyright Act, and claim therefore is preempted by 17

cèmber 4, 1999, asserting claims for breach of breach of confidence. MTVN removed the case to this court on February 4; 2000, and for Anne Arundel County, Maryland, on Decontract, violation of the Lanham Act, and filed its motion to dismiss on April 3, 2000. Fischer & Viacoin International Inc. is no more than agreement not to use his ideas without permission or payment, and since this alleged contract did not regulate parties' conduct beyond mere use of plaintiff's ideas.

motions 16 dixmiss under Federal Rule The Pourly Circuit tecently summarized the basic principles governing the resolution of 12(b)(6):

> (3) Elements of copyright — Federal preempiloo -- Statutory preemption

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(§ 205,0803)

TRADEMARKS AND UNFAIR TRADE

PRACTICES

- Preemption

Unfair competition

(§ 395.02)

The purpose of a Rule 12(b)(6) motion is due and orawing an reasonable factual in-ferences from those facts in the plantiffs fenses. Republican Parry v. Martin, 980 8 Rule 12(b)(6) motion should only be granted if, after accepting all well-pleaded allegations in the plaintiff's complaint as cannot prove any set of feets in support of his claim childing him to relief. See id. We do note, however, that for purposes of to test the sufficiency of a complaint; "importantly, [a Rule 12(b)(6) motion] does not resolve contests surrounding the facts, the savor, it appears certain that the plaintiff Rule 12(b)(6), we lark not required to accept as true the legal conclusions ser forth in a ments of a claim, or the applicability of de-F.2d 943, 952 (4th Cir. 1992). Accordingly, plainuiff's complaint. See Disirics 28,

United Mine Workers of Am, Inc. v. Well: more Coal Corp., 609 F.2d 1083, 1085 (4th Edwards v. City of Goldsborn, 178 F3d 231, Cir. 1979). length, with no prior dealings, no promise of tween parties gave rise to "implied" duly of confidentiality, and no employment or personal relationship that could give rise to dury of trust, and thus do mot support plaintiffs contention that dealings and relationships be-Action by Steven Fischer and Blue. Dog Productions Inc. against Viacom International inc. and MITV Networks Inc. for violation of Lanham Act, breach of contract, and breach of

233-34 (4th Cir. 1999). Exhibits atteched to ters outside the pleadings are considered by the court, a defendant's motion to dismiss will be treated as one for summary judgment under Ruje 56. See Fed. R. Civ. P. 12(b)(6). the pleadings are considered part of the complaint. See Fed. R. Civ. P. 10(c). Where mat-

and his blue dog named Bluey. This char-In the late 1970s, Sleven Fischer created an animated character team called "Sieve & and his Friend the Bluesies, and a published collection of somic saries illed There's a Blue Bluey, comprised of "a guy named Steve" including an impublished manuscript, Bluey Dog Under My: Bed. In 1990, Fixther incorpocopyrighted works between 1989 and 1993 rated Blue Dog Productions, Inc., to publish & Tremaine, New York, N.Y.; Michael S. Li. bowitz and Michael John Collins, of Thomas of Tydings & Rasenberg, Baltimore, Md., for Sisting filled a commission in the Girents Paris

66 USPO2d

& Libowitz, Baltimore; for defendants.

Bizabeth A. McNamara, of Davis,

plaintiffs.

